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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,042	03/18/2002	Joseph Schlessinger	038602-1224	8380

22428 7590 08/29/2005

FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

YAO, LEI

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,042

Applicant(s)

SCHLESSINGER ET AL.

Examiner

Lei Yao, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 and 28-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/18/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: ID AAW77290.

5.200

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of invention IV (claims 23-27) in the reply filed on 7/21/05 is acknowledged. The traversal is on the ground(s) that examining all of the pending claims does not present an undue burden on the examiner and there is overlapping subject matter between many of the groups.

This has been considered but is deemed not to be persuasive. Although the invention groups have overlapping subject, they differ in the products of DNA, protein and antibody and they differ in the method of using the product and method of identifying a modulator for the product function. Because these inventions are distinct and the inventions have acquired a separate status in the art as shown by their different classification, and the search required for each group is not required for the other groups because each group requires a different non-patent literature search due to each group comprising different methods and steps. The requirement is still deemed proper and is therefore made **FINAL**.

In response to species election, Applicants made an election of Pap α (SEQ ID NO: 1) from group A. However, the election does not meet the requirement of species election in the office action filed 6/21/05 since Applicants is required to elect one species from group A and further one species from B for examination of invention Group IV. During the telephone conversation with Beth Burrous on August 12, 2005, a provisional election was made to prosecute species Pyk2 from group B and Affirmation of this election must be made by applicant in replying to this Office action.

After review and reconsideration of the elected species in light of the prior art, the species of Src is joined to the species Pyk2 for examination at this time.

Claims 1-36 are pending. Claims 1-22 and 28-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 23-27 are examined on the merits.

Oath/Declaration

It is noted that Oath/declaration is missing. Applicant is advised to submit the Oath/Declaration along with or before the reply to this office action.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on March 18, 2002 is considered by the examiner and initialed copy of the PTO-1449 is enclosed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 23-27 are rejected under 35 U.S.C. 102(a) as being anticipated by Roberts et al., (WO 98/36065, published day 8/2/98) as evidenced by search ID: AAW77290.

The specification on page 9 defines that Pyk2 comprise one family of protein tyrosine kinases (PTK).

Roberts et al., disclose a polypeptide (DEF), which is 99.7% identical to the Pyk2 binding protein, Pap α , SEQ ID NO: 1 as evidenced by protein search (ID AAW77290). Robertst et al., disclose a method for identifying a substance that modulates the interaction between DEF and Src. Roberts et al., disclose an exemplary method including the steps of contacting DEF in the reaction mixture with test compound, adding src protein as natural binding partner, and then determining whether the test compound modulates the interaction of src kinase with DEF (page 70 line 20-26). Roberts et al., also disclose that the reaction mixture can be a recombinant cell including a nucleic acid recombinantly expressing the binding protein, DEF (page 70 line 30-36). Roberts et al., further disclose a method of identifying a substance that

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modulates src binding protein using a cell-based assay by overexpressing a recombinant binding protein, DEF, in the presence and absence of a test compound, with the assay scoring the modulation of binding activity by the test compound (page 73, line 25-33). Roberts et al., also disclose an example, by which EDF is modulated in an embryos or cells by a test compound (page 73, line 33-35). Roberts et al., then disclose that the compound on cells may be applied not only in basic drug screening, but also in clinical trials (page 74, line 3-8).

2. Claims 23-27 are also rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al., (US Patent, 6475778, Priority to 2/14/1997).

The reference of Roberts et al., (WO 98/36065) and the reference of Roberts et al., (US Patent, 6475778) have same invention and are by same inventive entity.

Roberts et al., disclose a method for identifying a substance that modulates the interaction between DEF and Src. Roberts et al., disclose an exemplary method including the steps of contacting DEF in the reaction mixture with test compound, adding src protein as natural binding partner, and then determining whether the test compound modulates the interaction of src kinase with DEF (column 51, line 22-30). Roberts et al., also disclose that the reaction mixture can be a recombinant cell including a nucleic acid recombinantly expressing the binding protein (column 51, line 37-41). Roberts et al., further disclose a method of identifying a substance that modulates src binding protein using a cell-based assay by overexpressing a recombinant binding protein, DEF, in the presence and absence of a test compound, with the assay scoring the modulation of binding activity by the test compound (column 53, line 39-50). Roberts et al., also disclose an example, by which EDF is modulated in an embryos or cells by a test compound (column 53, line 50-54). Roberts et al., then disclose that the compound on cells may be applied not only in basic drug screening, but also in clinical trials (53, line 61-64).

Conclusion

No claims are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lei Yao, Ph.D. whose telephone number is 571-272-3112. The examiner can normally be reached on 8am-4.30pm Monday to Friday.

Any inquiry of a general nature, matching or file papers or relating to the status of this application or proceeding should be directed to Kim Downing for Art Unit 1642 whose telephone number is 571-272-0521

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lei Yao, Ph.D.
Examiner
Art Unit 1642

LY


SHEELA HUFF
PRIMARY EXAMINER